THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

Paper No. 49

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SEUNG-LYEOL CHOI

Appeal No. 95-2886
Application No. 07/791,226[1]

HEARD:
July 11, 1996

Before CARDILLO, JERRY SMITH, and FLEMING, Administrative Patent Judges.

FLEMING, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 9, 16 through 24 and 26. Claims 2 through 8 and 10 have been canceled. Claims 1, 11 through 15, 25 and 27 through 35

[1] Application for patent filed November 13, 1991.

have been withdrawn from consideration as not being drawn to the elected invention.

The invention relates to a method for storing and reading out information in a data bank of a video recording and reproducing system. On page 1 of the specification, Appellant discloses that a user of a video recording and reproducing apparatus will normally record personal notes, information pertaining to the recordings, in a separate notebook. On page 2, Appellant discloses that it is an object of his invention to provide a data bank for storage and retrieval of this information which is part of a video recording and reproducing apparatus.

The independent claim 9 is reproduced as follows:

9. A method for maintaining a data bank in a video recording device, said method comprising the steps of:

determining in a recording mode of said video recording device if a data bank reproduction mode is selected;

if the data bank reproduction mode is selected, recording data stored in a playback section of a recording medium and displaying the data on a display of the video recording device;

if the data bank reproduction mode is not selected, displaying a file index corresponding to files stored in the data bank on the display, and determining if a listed file of the files listed in the file index corresponds to the data;

if the data corresponds to the listed file, locating an end position of the file, recording the data on the recording medium and displaying the data on the display; and

if the data does not correspond to listed file, recording a position of a new file, naming the new file, adding the new file to the file index, recording the data on the recording medium and displaying the data on the display.

The Examiner does not rely on any references for the rejection.

Claims 9, 16 through 24 and 26 stand rejected as being unpatentable under the enablement provision of 35 U.S.C. § 112, first paragraph, as being based upon a disclosure which fails to adequately teach how to make and use the invention.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the briefs[2] and answer[3] for the respective details thereof.

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[2] Appellant filed an appeal brief on July 18, 1994. We will refer to this appeal brief as simply the brief. Appellant filed a substitute appeal brief on February 21, 1995 which the Examiner denied entry and therefore is not before us for our consideration. Appellant filed a reply appeal brief on May 8, 1995 which was entered into the record. We will refer to this reply appeal brief as simply the reply brief.

[3] The Examiner responded to the brief with an Examiner's answer, dated March 7, 1995. We will refer to the Examiner's answer as simply the answer. The Examiner responded to the reply brief with a letter, dated August 8, 1995, so noting that the reply brief had been entered. The Examiner offered no other response.

OPINION

We will not sustain the rejection of claims 9, 16 through 24 and 26 under 35 U.S.C. § 112, first paragraph.

In order to be enabling under 35 U.S.C. § 112, a patent application must sufficiently disclose an invention to enable those skilled in the art to make and use it. ***In re Buchner***, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332, (Fed. Cir. 1991). The specification need not disclose what is well known in the art. ***Lindemann Maschinenfabrik GMBH V. American Hoist & Derrick Co***, 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984). However, an examiner may reject a claim if it is reasonable to conclude that one skilled in the art would be unable to carry out the claimed invention. ***In re Buchner***, 929 F.2d at 661, 18 USPQ2d at 1332 *citing* ***In re Eynde***, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973).

The Examiner argues on page 4 of the answer that Appellant's Figure 1 simply shows a single box labeled data processor 51 and a single box labeled system controller 10, but fails to disclose how one of ordinary skill in the art could determine the hardware. The Examiner further argues that even if one could create the data processor and system controller, it would require

more than a reasonable amount of time to interconnect such an arrangement.

The enablement provision of 35 U.S.C. § 112, first paragraph, does not require that every detail must be disclosed but only that which is necessary for one of ordinary skill in the art to make and use the invention without undue experimentation. On pages 6 and 7 of the specification, Appellant discloses that the data processor 51 during recording converts the data received from the system controller 10 into an analog signal to be recorded on the recording medium, and supplies the converted analog signal to first and second data heads 23 and 24. Appellant further discloses that during reproducing, the data processor 51 converts the analog signal received from the first and second data heads 23 and 24 into a digital signal and supplies the digital signal to the system controller. Appellant argues on pages 4 and 5 of the brief that data processors that perform the functions of analog to digital conversion and digital to analog conversion are well known prior art devices and that it is within the skill of one of ordinary skill in the art to provide a processor to do analog to digital conversions.

On pages 8-18 of the specification, Appellant discloses that the system controller 10 implements a computer program shown as

flowcharts in Figures 2A and 2B. Appellant argues on pages 5 and 6 of the specification that the system controller is a well known computer and that it is within the skill of one of ordinary skill in the art of provide a computer program to do the functions as described by Appellant's Figures 2A and 2B flowchart.

Finally, Appellant argues in the reply brief on pages 5 and 6 that the interconnections between the data processor 51 and the system controller 10 are the interconnections that would have been readily recognized by one of ordinary skill in the art. Upon reviewing the specification, Appellant discloses that data representing the information that is recorded on first and second record media TM1 and TM2 are transferred between the system controller and the data processor. We fail to find any reasonable basis that these interconnections between the data processor 51 and the system controller 10 would require undue experimentation to implement the Appellant's invention.

Upon careful consideration of Appellant's disclosure, we do not find that the Examiner had a reasonable basis to doubt that the claimed invention could have been carried out based on the disclosure since the data processor and the system controller are clearly well known devices. Furthermore, we find that Appellant's specification and flowcharts shown in Figures 2A and

2B are sufficiently detailed such that one of ordinary skill in the programming arts would be able to provide a computer program to provide these functions within only routine experimentation.

In view of the above, we do not find that the Examiner has met the original burden of raising a reasonable challenge as to the adequacy of the enablement. Therefore, we find that one of ordinary skill in the art, without undue experimentation, would have been able to make and use the disclosed invention using these known prior art components.

We have not sustained the rejection of claims 9, 16 through 24 and 26 under 35 U.S.C. § 112, first paragraph. Accordingly, the Examiner's decision is reversed.

REVERSED

RAYMOND F. CARDILLO, JR.)
Administrative Patent Judge)
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JERRY SMITH) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
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MICHAEL R. FLEMING)
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